UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,004	09/11/2003	Dana Pavel	042933/267066	5937

826 7590 01/26/2007

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER	
CHERRY, STEPHEN J	
ART UNIT	PAPER NUMBER
2863	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/660,004	PAVEL ET AL.	
	Examiner	Art Unit	
	Stephen J. Cherry	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *9-11-2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 19-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims merely recite the manipulation of measured data and do not produce a tangible result. Although the claims recite obtaining position information, the claims do not produce a tangible result, such as displaying the information.

For further guidance, please see the following OG announcement:

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 and 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,510,381 to Grounds et al.

Regarding claim 1, Grounds teaches a method of obtaining a terminal location comprising: defining at least one connection of the terminal ('381, fig. 1, "wireless connection"); monitoring the terminal for establishment of a defined connection, the defined connection being established by the terminal ('381, fig. 3, ref. 310); monitoring the terminal for termination of the defined connection after the defined connection is established such that termination of the defined connection triggers obtaining a location of the terminal at the terminal ('381, fig. 3, 320), obtaining the location of the terminal at the terminal and in response to termination of the defined connection, obtaining the location of the terminal including (i) determining the location of the terminal at the terminal, or (ii) communicating with a location provider located remote from the terminal to thereby receive, at the terminal, the location of the terminal from the location provider, the location provider having determined the location of the terminal ('381, fig. 3, 320, 330, and col. 5, line 55).

Regarding claim 2, and in view of the rejection of claim 1 described above, Grounds teaches a method according to Claim 1, wherein defining at least one connection comprises defining at least one communication connection between the terminal and a predefined entity ('381, fig. 2, connection from 110 to 210).

Regarding claim 3, and in view of the rejection of claim 1 described above, Grounds teaches a method according to Claim 1, wherein defining at least one

connection comprises defining at least one logical connection each of which includes a context specifying termination of the respective logical connection, and wherein monitoring the terminal for termination of a defined connection comprises monitoring the terminal for the context specifying termination of the respective logical connection ('381, fig. 3, ref 310 and 320, and col. 5, line 55).

Regarding claim 4, and in view of the rejection of claim 3 described above, Grounds teaches method according to Claim 3, wherein the context specifying termination of the respective logical connection can be determined based upon information indicative of the context, and wherein monitoring the terminal for termination of the defined connection comprises monitoring for the information indicative of the context ('381, fig. 3, ref 310, 320, FFLAG, and col. 5, line 55).

Regarding claim 5, and in view of the rejection of claim 1 described above, Grounds teaches a method according to Claim 1 further comprising: transforming the location of the terminal to thereby define the terminal in a predetermined manner, and thereafter presenting the location of the terminal in the predetermined manner ('381, fig. 2, position information defined by 10 for display at 250-254).

Regarding claim 1, and in view of the rejection of claim 1 described above, Grounds teaches a method according to Claim 1, wherein monitoring the terminal for establishment of a defined connection comprises monitoring the terminal for establishment of a defined connection such that establishment of the defined connection triggers obtaining a location of the terminal ('381, fig. 3, ref. 300 and 360).

Regarding claim 7, Grounds teaches a system comprising: a terminal configured for establishing, and thereafter terminating, at least one defined connection, wherein the terminal is configured for being triggered to obtain a location of the terminal in response to termination of a defined connection ('381, fig. 1 and fig. 3, ref 320); and a location provider located remote from the terminal and configured for determining the location of the terminal terminal ('381, fig. 1, ref. 10), wherein the terminal being triggered to obtain the location of the terminal includes the teminal communicating with the location provider to thereby receive the location of the terminal from the location provider ('381, fig. 3, 320, 330, and col. 5, line 55).

Regarding claim 8, and in view of the rejection of claim 7 described above, Grounds teaches a system according to Claim 7, wherein the terminal is configured for establishing, and thereafter terminating, at least one defined communication connection between the terminal and a predefined entity ('381, fig. 1, ref. 5, and fig. 3, ref. 300 and 320).

Regarding claim 9, and in view of the rejection of claim 7 described above, Grounds teaches a system according to Claim 7, wherein the terminal is configured for establishing, and thereafter terminating, at least one defined logical connection each of which includes a context specifying termination of the respective logical connection, and wherein the terminal is configured for monitoring the terminal for termination of the defined connection by monitoring the terminal for the context specifying termination of the respective logical connection ('381, fig. 3, ref 310, 320, FFLAG, and col. 5, line 55).

Regarding claim 10, and in view of the rejection of claim 9 described above, Grounds teaches a system according to Claim 9, wherein the terminal is configured for determining the context specifying termination of the respective logical connection based upon information indicative of the context, and wherein the terminal is configured for monitoring the terminal for termination of the defined connection by monitoring for the information indicative of the context ('381, fig. 3, ref 310, 320, FFLAG, and col. 5, line 55).

Regarding claim 11, and in view of the rejection of claim 8 described above, Grounds teaches a system according to Claim 8 further comprising: a mapping processor configured for communicating with the location provider to transform the location of the terminal to thereby define the terminal in a predetermined manner such that the location of the terminal can be presented in the predetermined manner ('381, fig. 1, ref. 60).

Regarding claim 12, and in view of the rejection of claim 7 described above, Grounds teaches a system according to Claim 7, wherein the terminal is configured for being triggered to obtain a location of the terminal upon establishment of a defined connection ('381, fig. 3, ref. 310).

Regarding claim 13, Grounds teaches a terminal comprising: a controller configured for establishing, and thereafter terminating, at least one defined connection, wherein the controller is configured for monitoring the terminal for establishment of a defined connection, and for subsequent termination of the defined connection, and wherein the controller is configured for being triggered to obtain a location of the

terminal upon termination of the defined connection (381, fig. 1, ref. 5, and fig. 3), and wherein the controller is configured for obtaining the location of the terminal in response to termination of the defined connection, obtaining the location of the terminal including (i) determining the location of the terminal at the terminal, or (ii) communicating with a location provider located remote from the terminal to thereby receive the location of the terminal from the location provider, the location provider having determined the location of the terminal ('381, fig. 3, 320, 330, and col. 5, line 55).

Regarding claim 14, and in view of the rejection of claim 13 described above, Grounds teaches a terminal according to Claim 13, wherein the controller is configured for establishing, and thereafter terminating, at least one defined communication connection between the terminal and a predefined entity ('381, fig. 3, ref. 310 and 320).

Regarding claim 15, and in view of the rejection of claim 13 described above, Grounds teaches a terminal according to Claim 13, wherein the controller is configured for establishing, and thereafter terminating, at least one defined logical connection each of which includes a context specifying termination of the respective logical connection, and wherein the controller is configured for monitoring the terminal for termination of the defined connection by monitoring the terminal for the context specifying termination of the respective logical connection ('381, fig. 3, ref 310, 320, FFLAG, and col. 5, line 55).

Regarding claim 16, and in view of the rejection of claim 15 described above, Grounds teaches a terminal according to Claim 15, wherein the controller can determine the context specifying termination of the respective logical connection based upon information indicative of the context, and wherein the controller is configured for

monitoring the terminal for termination of the defined connection by monitoring for the information indicative of the context ('381, fig. 3, ref 310, 320, FFLAG, and col. 5, line 55).

Regarding claim 18, and in view of the rejection of claim 13 described above, Grounds teaches a terminal according to Claim 13, wherein the controller is configured for being triggered to obtain a location of the terminal upon establishment of the defined connection ('381, fig. 3, 310).

Regarding claim 19, Grounds teaches a computer program product for obtaining a terminal location, the computer program product comprising a computer-readable storage medium having computer-readable program code portions stored therein, the computer-readable program code portions comprising: a first executable portion for receiving at least one defined connection of the terminal ('381, fig. 3, "wireless connection"); a second executable portion for monitoring the terminal for establishment of a defined connection the defined connection being established by the terminal ('381, fig. 3, ref. 310); a third executable portion for monitoring the terminal for termination of the defined connection after the defined connection is established such that termination of the defined connection triggers obtaining a location of the terminal at the terminal ('381, fig. 3, 320, 330, and col. 5, line 55); and a fourth executable portion for obtaining the location of the terminal at the terminal and in response to termination of the defined connection, obtaining the location of the terminal including (i) determining the location of the terminal at the terminal, or (ii) communicating with a location provider located remote from the terminal to thereby receive, at the terminal, the location of the terminal

from the location provider, the location provider having determined the location of the temlinal ('381, fig. 3, 320, 330, and col. 5, line 55).

Regarding claim 20, and in view of the rejection of claim 19 described above, Grounds teaches a computer program product according to Claim 19, wherein the first executable portion is adapted to receive at least one defined communication connection between the terminal and a predefined entity ('381, fig. 1, 3 connected to 1-2).

Regarding claim 21, and in view of the rejection of claim 19 described above, Grounds teaches a computer program product according to Claim 19, wherein the first executable portion is adapted to receive at least one defined logical connection each of which includes a context specifying termination of the respective logical connection, and wherein the third executable portion is adapted to monitor the terminal for the context specifying termination of the respective logical connection ('381, fig. 3, ref 310, 320, FFLAG, and col. 5, line 55).

Regarding claim 22, and in view of the rejection of claim 21 described above, Grounds teaches a computer program product according to Claim 21, wherein the context specifying termination of the respective logical connection can be determined based upon information indicative of the context, and wherein the third executable portion is adapted to monitor for the information indicative of the context ('381, fig. 3, ref 310, 320, FFLAG, and col. 5, line 55).

Regarding claim 23, and in view of the rejection of claim 19 described above, Grounds teaches a computer program product according to Claim 19 further comprising: a fifth executable portion for transforming the location of the terminal to

thereby define the terminal in a predetermined manner such that the location of the terminal can thereafter be presented in the predetermined manner ('381, fig. 3, ref. 360).

Regarding claim 24, and in view of the rejection of claim 19 described above, Grounds teaches a computer program product according to Claim 19, wherein the second executable portion is adapted to monitor the terminal for establishment of a defined connection such that establishment of the defined connection triggers obtaining a location of the terminal ('381, fig. 3, 320).

Regarding claim 25, and in view of the rejection of claim 1 described above, Grounds teaches a method according to Claim 1, wherein the defining and monitoring steps include defining at least one short-range connection of the terminal, and monitoring the terminal for embellishment and termination of the short-rage connection, at least one short-range connection being selected from the group consisting of an infrared connection, a radio frequency identification connection and a Bluetooth connection (381, fig. 5, Bluetooth).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,035,381 to Grounds in view of U.S. Patent 5,345,388 to Kashiwazaki.

The claim recites, as disclosed by Grounds, a controller configured for establishing, and thereafter terminating, at least one defined connection, wherein the controller is configured for monitoring the terminal for establishment of a defined connection, and for subsequent termination of the defined connection, and wherein the controller is configured for being triggered to obtain a location of the terminal upon termination of the defined connection (381, fig. 1, ref. 5, and fig. 3), and wherein the controller is configured for obtaining the location of the terminal in response to termination of the defined connection, obtaining the location of the terminal including (i) determining the location of the terminal at the terminal, or (ii) communicating with a location provider located remote from the terminal to thereby receive the location of the terminal from the location provider, the location provider having determined the location of the terminal ('381, fig. 3, 320, 330, and col. 5, line 55) Grounds does not explicitely disclose a display displaying location.

The claim further recites, as disclosed by Graham:

> a display capable of presenting the location of the terminal in the predetermined manner ('388, col. 10, line 7).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the display of Kashiwazaki with the invention of Grounds to

allow the user of a wireless phone to know their position to support driving of an automobile ('388, col. 1, line 6)

Response to Arguments

Applicant's arguments filed 10-17-2006 have been fully considered but they are not persuasive.

Regarding the 35 U.S.C 101 rejection, the applicant argues that the claims each produce a real-world result. The applicant is reminded that MPEP 2106 states: "the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is "useful, tangible and concrete". The final step of claim 1, for example, is obtaining a location. As such, the final result of this method is a number. Although, the number is representative of a real world property, the result is simply a number not a practical application of the number as required. Until the number is claimed as used in a practical application or claimed so that the number is made available in such a manner that its usefulness in a disclosed practical application can be realized, it cannot be said to be tangible. Additionally, because the computer program of claims 19-25 do not produce a tangible result, the claim is drawn to non-statutory subject matter.

The applicant is further directed to Annex III: Improper Tests for Subject Matter Eligibility in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (OG Notice: 22 November 2005).

Regarding the prior art rejection of the claims, applicant states the Grounds does not teach termination of a connection triggering a terminal to obtain it's location;

however, this feature is shown in figure 3. Particularly, figure 3 depicts a flowchart of operation of a system that continuously loops during operation. Therefore as the program executes the decision block leading to block 330, termination of a connection will result in the "no" decision, leading to block 330, thereby meeting the language of the claim limitation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Cherry whose telephone number is (571) 272-2272. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SJC

MICHAEL NGHIEM
PRIMARY EXAMINER